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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,637	02/23/2004	Joseph P. Errico	F-270	8185
51640	7590	09/25/2007	EXAMINER	
SPINE MP			PELLEGRINO, BRIAN E	
LERNER, DAVID, et al.			ART UNIT	PAPER NUMBER
600 SOUTH AVENUE WEST			3738	
WESTFIELD, NJ 07090				
MAIL DATE		DELIVERY MODE		
09/25/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ED

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/784,637	ERRICO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Brian E. Pellegrino	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 June 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 and 13-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8, 13, 16-21 and 24 is/are rejected.
- 7) Claim(s) 14, 15, 22 and 23 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Priority***

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application **must include the relationship** (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Landry et al. (2003/233145). Fig. 1 shows an artificial intervertebral disc with two baseplates 12', 12". Fig. 6 illustrates a coupling 14 that is disposed between the baseplates that permits articulation, see also paragraph 104. Figs. 37,41-44,47,48,55 illustrate tools for inserting the spinal devices and have tines 430, 1004,1006, 1116 respectively. It can also be seen (Fig. 1) that the baseplates have spikes 24 for securing to the vertebrae. Figs. 41-44 show the tool having a handle and that the instrument can apply force in the proximal and distal direction for insertion of the spinal implant. Fig. 37 illustrates the tool has a stop 462 to prevent over insertion. Fig. 48 illustrates the tine is tapered at its end.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 7,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landry et al. (2003/233145). Landry is explained supra. However, Landry fails to disclose the intervertebral disc has an upper baseplate with a lower surface that is flat and an upper surface of the lower baseplate being curved that corresponds with tines of the tool. It would have been an obvious matter of design choice to modify the corresponding engagement surfaces of the tines and baseplates, since applicant has not disclosed that using curved and flat contours provide any advantage, or solve a stated problem, or are used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the matching contours of the tines and baseplates taught by Landry et al. or the claimed flat and curved surfaces in claim(s) 7,8 because both spinal implant systems perform the same function of delivering a movable spinal implant between the vertebrae.

Claims 1,4,13,16-21,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gill et al. (6113637) in view of Neumann (6752832). Gill et al. show (Figs. 3,6) an artificial intervertebral disc with two baseplates **22,24** coupled with a single central coupling of components **30,50**. Fig. 16,17 show an insertion tool with a shaft **74** and a tine **79** at the distal end that is inserted between the baseplates and a vertebral stop **78**. However, Gill et al. fail to disclose the tool can have two tines parallel to one another for straddling the coupling. Neumann teaches (Fig. 12) a movable two

piece spinal implant that is inserted with a tool having tines **28** that are parallel to one another and straddles the central coupling. It would have been obvious to one of ordinary skill in the art to modify the tool of Gill and include two tines as taught by Neumann for provide more control and grip of the implant for insertion purposes.

***Allowable Subject Matter***

Claims 14, 15, 22, 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 6/25/07 have been fully considered but they are not persuasive. Applicant argues that the implant of Landry does not have a central coupling. The examiner is interpreting the claimed elements "central coupling" in this way: central to be between. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). See also *In re Morris*, Fed. Cir. 1997 127 F3d 1048, 1054, 1055. Clearly Landry illustrates that the plates have a coupling between or "central" to one another even as admitted by Applicant. Additionally, in response to Applicant's argument that Landry includes additional structure or an extra coupling not required by Applicant's invention, it must be noted that Landry discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant to the issue of patentability. Applicant also argues the tines do not straddle the coupling. The Examiner is entitled to give terms in a claim its plain meaning as interpreted by one of ordinary skill in the art. It is noted that

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the specification must clearly set forth the definition explicitly and with reasonable clarity, deliberateness, and precision. Exemplification is not an explicit definition. Even explicit definitions can be subject to varying interpretations. See *Teleflex, Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*, 60 USPQ2d 1851,1854 (Fed. Cir. 2001) and MPEP 2111.01. The tines of Landry's tool clearly are around the exterior of the couplings and thus can be considered to straddle. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., engaging the coupling at multiple locations or sides) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on M-F (7:30am-4pm) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TC 3700, AU 3738

  
BRIAN E. PELLEGRINO  
PRIMARY EXAMINER